

REMARKS

The Official Action of May 2, 2006, and the prior art relied upon therein have been carefully studied. The claims in the application are now claims 6-19, and these claims are submitted and believed to define novel and unobvious subject matter, thus warranting their allowance. Applicants respectfully request favorable reconsideration and allowance.

Acknowledgement by the PTO of the receipt of applicants' papers filed under Section 119 is noted.

Claims 1-5 have been deleted and have been replaced with very similar claims 6-10, respectively. New claims 11-19 have been added to further define the invention, and these claims are patentable for the reasons pointed out below.

As regards the election of species requirement, applicants affirm the election of Species I, previously claims 1-3 and now claims 6-8. Consequently, new claims 9 and 10, which replace non-elected claims 4 and 5, have been marked "withdrawn", although applicants believe that such designation may indeed be incorrect for reasons pointed out below.¹

¹ Applicants in general object to this designation "Withdrawn", as required by the PTO, before it has been finally determined that such claims are indeed "Withdrawn".

The election of species requirement is respectfully traversed because it is unclear to applicants on what basis it has been determined that claims 4 and 5 are directed to a different species than claims 1-3. Applicants respectfully note in this regard that claim 2 specifically recited "plum seed charcoal", which is presumably the basis for separating claims 4 and 5 from claims 1-3. Stated another way, applicants believe that claims 1 and 2 could indeed be deemed generic claims, contrary to what is stated in the Official Action.

In rewriting claims 1-5 as new claims 6-10, applicants have attempted to bring out more clearly the generic nature of the invention. Applicants accordingly believe that all of the claims now pending, namely claims 6-19, constitute elected subject matter. If the examiner disagrees, applicants would appreciate an explanation as to the basis of the election requirement.

Support for the last clause of claim 13 is to be found in applicants' specification at page 5, lines 4-6, where it is made clear that the charcoal which is a component of the present invention is "equal to... activated charcoal" with respect to its capability for cleaning nitrogen and organisms. Moreover, the cited reference, the publication of Heschel et al, indicates on its first page (page 1789) near the bottom of

the second column, that activation involves a two-step process. The "spent grain charcoal" used in the present device (support for "spent grain charcoal" is found at column, line 19) is therefore different from "activated charcoal".

Support for new claim 17 is both implicit from the specification and is also clear from Figs. 1 and 2 and the specification at page 2, lines 27 and 28. In this regard, applicants respectfully refer to the rejection of paragraph 7 of the Official Action, made under the second paragraph of §112, on the basis that claim 1 contains apparatus limitations. Applicants wish to point out that the present invention is directed to an apparatus or a device or a structure, not simply charcoal per se.

Support for new claims 18 and 19 is to be found in the examples, for example at page 3, lines 12 and 24.

Claims 1-3 have been rejected under the second paragraph of §112. The rejection is respectfully traversed.

Applicants respectfully disagree that an applicant must claim structure the applicant does not wish to claim. Various structural parts of the apparatus or device do not go to the essence of the claimed invention. It is only necessary that the device be specified, and that has been done. The device is an aquarium-cleaning device, and those skilled in the art know what these devices are. The claims are broad in

this regard, but not indefinite. This accordingly applies to the new claims.

In addition, claims 8 and 10 specify that the aquarium-cleaning device is part of an aquarium, which adds further structure; this also applies to new claim 16. New claims 13-17 and 19 are Jepson form claims in which whatever additional structure may be needed is implicitly recited in the Jepson preamble. New claim 17 adds some additional structural elements.

Withdrawal of the rejection is in order and is respectfully requested.

Claims 1-3 have been rejected under §102 as anticipated by Heschel et al, reference AC of the IDS filed February 21, 2006, entitled "On the suitability of agricultural by-products for the manufacture of granular activated carbon", hereinafter simply "Heschel". The rejection is respectfully traversed.

First, while Heschel does disclose the suitability of various raw materials for the manufacture of **activated** carbon, and that such activated carbon is appropriate for the purification of drinking water or waste water, Heschel does not disclose what applicants have claimed, namely an "aquarium-cleaning device" of any kind. Therefore, there can be no anticipation for this reason alone.

Next, the charcoal of Heschel is an activated charcoal which has been subjected to a two-step activation process. Applicants' charcoal need not be activated.

Moreover, of all the raw materials useful for the manufacture of the type of charcoal used in the device of the present application, Heschel discloses only plum seeds, and these are excluded from applicants' claims 12 and 14.

Lastly, the particle size of the carbon manufactured according to Heschel is 2-4 mm, or even less (1-2.5 mm, per the top line on the left hand column on page 1787), whereas the particle size of the charcoal as called for in claims 18 and 19 is 5-10 mm.

It is clear that Heschel does not anticipate any of applicants' claims. The rejection does not apply to applicants' claims; accordingly, applicants respectfully request withdrawal of the rejection.

No rejections have been imposed under §103, and applicants agree that applicants' claims would not have been obvious from any known prior art. Certainly, there is no prior art applied which would have made it obvious to modify Heschel in any way to reach the applicants' claimed subject matter.

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The prior art documents of record and not relied upon by the PTO have been noted, along with the implication that such documents are deemed by the PTO to be insufficiently material to warrant their application against any of applicants' claims.

Applicants believe that all issues raised in the Official Action have been addressed above in a manner that should lead to patentability of the present application. Favorable consideration and early formal allowance are respectfully requested.

Respectfully submitted,

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